

REMARKS

Claims 37-43 have been canceled due a restriction under 35 U.S.C. 121. As such, claims 1-36 are currently pending in the case. Further examination and reconsideration of the presently claimed application are respectfully requested.

Section 121 Restriction:

As stated in the Office Action, a provisional election was made with traverse by Kevin Daffer on April 1, 2003 to prosecute device claims 1-36 in response to the restriction requirement under 35 U.S.C. § 121. The argument traversing the restriction of one group of claims 1-36 and 37-43 was not accepted by the Examiner. This Amendment affirms the election of Group I device claims 1-36 and the cancellation of non-elected Group II method claims 37-43. The Applicant, however, reserves the right to file a divisional application at a later date to capture the subject matter recited in non-elected claims 37-43. The Office Action states “[c]laims 34 to 37 are withdrawn from further consideration by the examiner ... as being drawn to a non-elected invention.” (Office Action -- page 2.) Such a statement is believed to have been made in error since claims 34-36 are dependent upon independent claim 19 and are, therefore, included within elected Group I claims. It is presumed claims 1-36 are still pending in the case and claims 37-43 have been withdrawn from consideration as noted in the Office Action Summary.

Objections to the Claims

Claims 24 and 29-36 were objected to as being dependent upon a rejected base claim. Applicant sincerely appreciates the Examiner’s recognition of the patentable subject matter recited in this claim. However, as will be set forth below, claim 19 is patentably distinct from the cited art. Since claims 24 and 29-36 are dependent upon base claim 19, Applicants assert that they are also allowable over the cited art. Accordingly, removal of this objection is respectfully requested.

Section 102(e) Rejections

Claims 1-4, 6-8, 11-16, 18-23, and 25-28 were rejected under 35 U.S.C. § 102(e) as being unpatentable over either U.S. Patent No. 6,529,093 to Ma (hereinafter referred to as “Ma”). This rejection is respectfully traversed as set forth in more detail below.

Ma is not available as prior art against the current application. To expedite prosecution, a declaration under 37 C.F.R. § 131 is filed with this response. The declaration establishes an invention date prior to July 6, 2001 for the subject matter of the current claims. Ma was filed on July 6, 2001 and, therefore, it is not available as prior art under 35 U.S.C. § 102(e) against these claims. Accordingly, removal of this rejection is respectfully requested.

Section 103(a) Rejections

Claims 5, 9, 10, and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ma in view of U.S. Patent No. 6,486,425 to Seki (hereinafter referred to as "Seki"). As set forth above, Ma is not available as prior art against the current application. Consequently, no reference can be cited with Ma to teach the limitations of the present claimed case. As such, removal of the § 103(a) rejections of claims 5, 9, 10, and 17 is respectfully requested.

In addition to arguing the patentability of claims 1-19 for the reasons cited above, some of the statements included in the Office Action regarding the claims of the present case are traversed.

For example, the Office Action states "Seki teaches an insulating element interposed between the ends of the beam ..." (Office Action -- page 4). It is asserted, however, that there is no teaching or suggestion within Seki of having moveable electrode 25 include an insulating element interposed between the beam's ends. The Office Action supports the aforementioned statement by citing Fig. 1b and Fig. 6b, particularly element 38 of Fig. 6b. Such citations, however, are void of an insulating element between the ends of moveable electrode 25. In particular, Seki cites element 38 in Fig. 6b as a connecting member of support member 31. Consequently, element 38 does not serve as an insulating element of moveable electrode 25, much less as an insulating element interposed between ends of moveable electrode 25. Similarly, the device illustrated in Fig. 1b of Seki does not include an insulating element interposed between ends of the beam. Although Figs. 1b and 6b in Seki show moveable electrode having portions with cross-hatch marks and other regions without cross-hatch marks, it is asserted that such a distinction between the regions is not indicative of differing materials, but rather, is indicative of cutouts made within the electrode. More specifically, it is asserted that beam members 22 of moveable electrode 25 may be connected by remaining portions of silicon layer 103 subsequent to the formation of cutout 26a and slits 26b and 26c. See Fig. 3I and related text of the application in columns 4 and 5, lines 63-67 and 1-4, respectively.

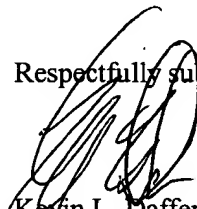
In addition, the declaration in the Office Action stating “[a]n upper surface of a contact structure being above upper surfaces of additional contact structures would have been obvious to one of ordinary skill in the art at the time the invention was made” is traversed. First of all, there is no teaching or suggestion within the cited art of including more than one contact structure between a pair of electrodes as taught in the presently claimed case. As such, there is no motivation within the cited art to teach a MEMS device with contact structures of different heights. Furthermore, even if the cited art taught a device with multiple contact structures, it is asserted that it would not be obvious to one skilled in the art to alter the heights of the contact structures without some motivation to do so.

CONCLUSION

This response constitutes a complete response to all of the issues raised in the Office Action mailed April 23, 2003. In view of the remarks traversing the rejections presented therein, Applicants assert that pending claims 1-36 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned attorney earnestly requests a telephone conference.

No fees are required for filing this amendment; however, the Commissioner is authorized to charge any additional fees, which may be required, or credit any overpayment, to Conley Rose, P.C. Deposit Account No. 03-2769/5683-00500.

Respectfully submitted,



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